

REMARKS

ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:

Applicant(s) request(s) entry of this Rule 116 Response and Request for Reconsideration because:

(a) at least certain of the rejected claims have been canceled thereby at least reducing the issues for appeal;

(b) it is believed that the amendments of claims 3-7, 11, 13, 14, 19, 25, 26, 31, 32, 33, 34, 35, 36, and 39 puts this application into condition for allowance as suggested by the Examiner;

(c) the amendments were not earlier presented because the Applicants believed in good faith that the cited prior art did not disclose the present invention as previously claimed;

(d) the amendments of claims 3-7, 11, 13, 14, 19, 25, 26, 31, 32, 33, 34, 35, 36, and 39 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and/or

(e) the amendments do not significantly alter the scope of the claims and place the application at least into a better form for appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

CHANGES TO THE CLAIMS:

The limitation of "and greater than 0.5 mM" is based on the fact that the examples of solvents used for the second component shown as Nos. 9-24 of Table 1 recite sulfur solubilities of 1.4 to 7.8 mM. Hence, it is respectfully submitted that addition of a limitation of "and greater than 0.5 mM" to the description of the second component is within the scope of the present invention. However, the claims have been reviewed in response to this Office Action, and changes have been made to the claims only to place it in preferred and better U.S. form for issuance, and to resolve the Examiner's objections raised on page 2 in the Office Action. Dependent sets of corresponding claims for allowed new claims have been cancelled without prejudice or disclaimer. No new matter has been added.

REJECTION UNDER 35 U.S.C. §102:

In the Office Action, at page 2, claims 1, 3, 5-7, 11, 13-17, 19, 20-23, 26-28 and 30-33 were rejected under 35 U.S.C. §102 in view of Griffin et al. (USPN 5,552,244). This rejection is traversed and reconsideration is requested.

Claims 1, 2, 8, 17, 18, 23, 24, 25, 28 and 29 have been cancelled without prejudice or disclaimer. Thus, the rejection of claims 1, 17, 23, and 28 under 35 U.S.C. §102 in view of Griffin et al. (USPN 5,552,244) is now moot.

Claim 13 was amended to include the limitations of claim 24, and is now believed to be in allowable form under 35 U.S.C. §102 in view of Griffin et al. (USPN 5,552,244).

Claims 3-7, 11, 14, 19, 25, 26, 30, 31, 32, 33, 34, 35, 36, and 39 have been amended in accordance with the objection to new matter raised by the Examiner and to place the claims in form for allowance in accordance with the suggestions of the Examiner. Thus, it is respectfully submitted that since claims 3, 5-7, 11, 14-16, 19, 20-22, 26-27 and 30-33 depend from independent claims 34, 14, 37, which are submitted to be in allowable form under 35 U.S.C. §102 in view of Griffin et al. (USPN 5,552,244), claims 3, 5-7, 11, 14-16, 19, 20-22, 26-27 and 30-33 are submitted to be allowable under 35 U.S.C. §102 in view of Griffin et al. (USPN 5,552,244) for at least the reasons that claims 34, 14, and 37 are submitted to be allowable over same.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action, at pages 4-5, claims 4 and 12 were rejected under 35 U.S.C. §103 as being unpatentable over Griffin et al. (USPN 5,552,244) as applied above, and further in view of Omaru (USPN 5,437,945). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Claim 34 has been amended to delete the subject matter determined by the Examiner to be new matter. Thus, amended claim 34 is submitted to be in allowable form, as indicated on page 5 of the Office Action. Since claims 4 and 12 have been amended to depend from amended claim 34, amended claims 4 and 12 are submitted to be allowable under 35 U.S.C. §103 over Griffin et al. (USPN 5,552,244), and further in view of Omaru (USPN 5,437,945), for at least the reasons that amend claim 34 is allowable over same.

ALLOWABLE SUBJECT MATTER:

Claims 2, 8-10, 18, 24-25 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2, 8, 18, 24, 25, and 29 have been cancelled without prejudice or disclaimer. Claim 35, from which claims 9 and 10 depend, has been amended in accordance with the Examiner's suggestions and is now believed to be in allowable form. Thus, claims 9 and 10 are submitted to be allowable for at least the reasons that amended claim 35 is allowable.

Claims 34-36 and 39 are allowable pending deletion of subject matter that the Examiner determined was new subject matter and cancellation of corresponding dependent claims. Claims 34-36 and 39 have been amended in accordance with the Examiner's suggestion and corresponding dependent claims have been cancelled without prejudice or disclaimer. Thus, amended claims 34-36 and 39 are submitted to be in allowable form.

Claims 37-38 are allowed.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further

outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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